

### **REMARKS**

Claims 1-4, and 9-23 are now pending in the application. Claims 5-8 have been cancelled, without prejudice. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

The currently pending Office Action has been indicated as a Final Office Action, despite being the first Office Action after the filing of a request for continued examination. Applicants respectfully assert that a good faith attempt to overcome the outstanding rejections was made, including multiple amendments to the claims, in the Response filed along with the request for continued prosecution. Applicants believe that the currently pending Office Action should not have been made final solely based on the fact that the Examiner did not agree that Applicants' good faith amendments and arguments overcame the rejections. In order to avoid abandonment of the currently pending application, Applicants have filed a further request for continued prosecution. Applicants respectfully request, however, that the finality of the current Office Action be withdrawn (thereby eliminating the need for the request for continued prosecution and allowing Applicants to seek a refund of the applicable fees).

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 2-4, 6, 8, and 9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter

which Applicant regards as the invention. This rejection is respectfully traversed, overcome or rendered moot.

Applicants have amended Claim 2 to eliminate the language alleged to be unclear. Accordingly, Applicants respectfully asserts that Claim 2 is in full compliance with 35 U.S.C. § 112, second paragraph. In addition, Claim 8 has been cancelled, without prejudice. Applicants understand that this rejection has been applied to the remaining claims solely because they depend from Claim 2. Accordingly, Applicants respectfully assert that all of these claims are likewise in full compliance with 35 U.S.C. § 112, second paragraph.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-4, 9-13 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Masafumi in view of Patel (U.S. Pat. No. 5,639,447). Claims 6, 14-16 and 18-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Masafumi in view of Patel (U.S. Pat. No. 5,639,447) as applied above, and further in view of Ohnishi (U.S. Pat. No. 5,928,989) for reasons of record in the Office Action dated 06/02/06. These rejections are respectfully traversed.

Independent Claims 1, 2 and 10 recite a method and a thermal transfer sheet including a first colorant or colored layer and a second colorant or colored layer in this order side by side provided on a surface of the substrate sheet. Accordingly, the first and second colorants or colored layers are claimed as **adjacent** to each other on the substrate, not one on top of the other. Independent Claims 1 and 2 further recite **forming a first image** using the first colorant and **forming a second image** using the

second colorant. Thus, the present printing method can form a first image and a second image on surface of the substrates, **individually**, so as to obtain full color images having rainbow color. Particularly, the present invention can provide various full color images which are visually perceivable or unperceivable depending upon light reflection, which can be used to verify authenticity thereby providing security. See, the specification at page 2, lines 25 to 30 and page 3, lines 18 to 30. These independent claims further recite that the first colorant or the second colorant includes **a pearl pigment** (which can provide rainbow or prismatic colors) as colorant **and a fluorescent agent or a fluorescent brightening agent**. These independent claims additionally recite the use of an **intermediate thermal transfer sheet**.

In contrast, Masafumi discloses a thermal transfer sheet comprising a base material sheet 1, a release layer 3, a heat transfer ink layer 2, and an adhesive layer 4 **in that order stacked on the base material sheet 1 in a vertical direction**, in the disclosure of the Abstract and figure 2. Although the adhesive layer may contain black or blue as a colorant above the heat transfer ink layer 2, Masafumi does not disclose or suggest forming individual **first and second images** using **side by side** (i.e., adjacent) first and second colorants as recited in independent Claims 1 and 2. In addition, Applicants believe that Masafumi fails to disclose or suggest an **intermediate thermal transfer sheet** as recited in independent Claims 1, 2 and 10

Furthermore, although the adhesive layer 4 may contain black or blue but does not contain another colorant, for instance, Y, M or C; and **a fluorescent agent or a fluorescent brightening agent** as recited in the independent claims. Likewise, the heat transfer ink layer 2 does not contain a fluorescent agent or a fluorescent

brightening agent. Accordingly, Masafumi does not disclose or suggest the use of a fluorescent agent or a fluorescent brightening agent as recited in the independent claims.

The Office Action cites Patel as disclosing the claimed fluorescent agent or a fluorescent brightening agent. Applicants respectfully assert that Patel is not relevant to the present invention as prior art, since Patel clearly differs from the present invention in technical field and the problem being solved. The present invention relates to the technical field of "printing" and the Patel invention relates to the technical field of a "makeup or cosmetic product." In addition, the selection and usage of colorant by "printing" method is duly distinguishable from that by "makeup or cosmetic product". Many ingredients of ink compositions would not be suitable for use in a makeup or cosmetic composition and visa versa. Furthermore, the problem being solved by the use of a brightening agent in Patel has nothing to do with whether the composition includes a pearlized pigment as suggested by the Office Action. The problems being solved are related to the different uses; i.e., ink vs. cosmetic composition. In any event, Patel adds nothing to Masafumi regarding providing a first colorant or colored layer and a second colorant or colored layer side by side which permits individual first and second images to be formed as recited in the independent claims, or the use of a an intermediate thermal transfer sheet.

Applicants understand that Ohnishi is being cited in the rejection solely as disclosing a protective thermal transfer layer of some independent claim(s). Accordingly, Applicants understand that Ohnishi likewise adds nothing to these rejections regarding providing a first colorant or colored layer and a second colorant or

colored layer side by side which permits individual first and second images to be formed as recited in the independent claims, or the use of a an intermediate thermal transfer sheet.


Accordingly, Applicants respectfully assert that Masafumi, Patel and Ohnishi do not disclose or suggest, either singly or in combination, Applicants' invention as recited in independent Claims 1, 2, and 10 as asserted by these rejections. Since each of the remaining claims depends from one of these independent claims, Applicants respectfully assert that they are likewise patentable over these rejections for at least the reasons discussed above.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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